REMARKS

Claims 1-55 are pending in the Application. Claims 18, 38, and 46-47 have been amended. Claims 48-55 have been added. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claims 18 and 38 have been amended to correct typographical errors.

Claim 47 has been written into independent form.

Claims 48-55 find basis in the Specification and claims. Claims 48-55 find basis in original claims 1, 46 and 47. Claim 50 finds additional basis in at least claim 19. Claims 53-55 find additional bases in at least claim 3.

The Abstract has been shortened to less than 150 words.

The Specification has been amended to contain a priority statement. Applicants respectfully submit that their initial application transmittal papers already requested entry of a priority statement by amendment. However, the Action does not acknowledge Applicants' claim for priority. Therefore, please consider the priority statement herein (upon entry) a substitution therefor.

The Legal Standard

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would

literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C. § 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or

motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

It is respectfully submitted that the Action does not meet these burdens.

35 U.S.C. § 102 Rejections

For brevity the Applicants do not necessarily present all of the reasons as to why the applied Murphy reference (US 5,305,195) does not anticipate the claims. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' remarks herein show that the reference does not teach every feature, relationship, and step arranged in the manner recited in the claims, as is required to sustain the rejections.

Murphy Does Not Anticipate The Claims

Claims 1-29, 31-34, and 36-47 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Murphy. The Applicants respectfully disagree with the interpretation and application of the Murphy reference.

Claim 1

Murphy does not teach at least steps (c), (e), and (f). Where does Murphy teach sending a marketing request message from a transaction machine to a first computer, especially where the

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marketing request message includes <u>user data</u> corresponding to an <u>identifying</u> input from the user? Where does Murphy teach selecting (through operation of the first computer) <u>data</u> corresponding to a <u>presentation</u> to be made to the user, responsive to the <u>user data</u>? Where does Murphy teach sending from the first computer to the transaction machine a marketing response message including <u>presentation data</u> corresponding to the presentation? Where does Murphy teach a transaction machine, a first computer, user data (corresponding to an identifying input from the user), presentation data (selected responsive to the user data), and the relationships thereof? The Applicants respectfully submit that Murphy does not teach the features, relationships, and steps in the manner recited.

In Murphy the selection of the advertising message is determined by the message stored on the terminal hard disc (col. 3, lines 64-65). There is no teaching in Murphy that the selection is related to user data, especially user data corresponding to an identifying input from the user. In Murphy it appears that each of the students receives the same (latest) advertising message (e.g., col. 7, lines 53-60). The advertising message is stored on a hard disc (74) and updated periodically (col. 3, lines 65-68). The updated message is transmitted at low speeds and stored when a terminal is not being used (col. 2, lines 54-58). Murphy does not anticipate claim 1.

Claim 46

Applicants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Murphy does not teach communicating messages between a transaction machine and both a first computer (associated with carrying out a financial transaction for the user) and a second computer (associated with marketing a product to the user), and marketing a product to the user responsive to user identifying data. As previously discussed,

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there is no teaching in Murphy of marketing a product to a specifically identified user. Murphy is not concerned with user identity with regard to marketing. Murphy is unable to market a specific product to a specific user. Murphy does not anticipate claim 46.

Claim 47

Claim 47 has been written into independent form.

Applicants' remarks in support of the patentability of claim 1 are incorporated by reference as if fully rewritten herein. Murphy does not teach communicating marketing messages between a transaction machine and a second computer while concurrently carrying out a financial transaction for a user by communicating financial transaction messages between the transaction machine and a first computer. As previously discussed, in Murphy the advertising message is updated periodically when a terminal (38) is not in use (e.g., col. 2, lines 54-58). Murphy does not teach updating the advertising message with the commercial computer (30) while concurrently carrying out a financial transaction with the college mainframe (36). Murphy does not teach the recited features, relationships, and steps. It follows that Murphy does not anticipate claim 47.

The Dependent Claims

Each of the dependent claims depends directly or indirectly from an independent claim. The independent claims have been previously shown to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis.

Furthermore, each of the dependent claims additionally recites specific features and relationships that patentably distinguish the claimed invention over the applied art. The applied

art does not teach the features and relationships that are specifically recited in the dependent claims. Thus, it is respectfully submitted that the dependent claims are further allowable due to the recitation of such additional features and relationships.

35 U.S.C. § 103(a) Rejections

Claims 30 and 35 were rejected under 35 U.S.C. § 103(a) as obvious over Murphy in view of Symonds.

Claims 30 and 35

Claim 30 depends from claim 1. Claim 35 depends from claim 9. Symonds cannot alleviate the previously discussed deficiencies of the Murphy reference. Nor does the Action attempt such alleviation with Symonds. The Action relies on Symonds as merely teaching an ISO 8583 message format.

The Action is silent as to how Murphy could be modified by Symonds to include the recited features and relationships. Furthermore, even if it were somehow possible for Murphy to have been modified with the teaching of Symonds, the alleged modification still would not have produced the recited invention, as previously discussed. Neither Murphy nor Symonds, taken alone or in combination, disclose or suggest the features and relationships that are specifically recited in the claims. Thus, it would not have been obvious to have combined the teaching of Murphy in view of Symonds to have produced the recited invention. The Office has not established a *prima facie* showing of obviousness.

Newly Added Claims

Newly added claims 48-55 are each allowable on at least the same basis as claim 1.

Claim 50 is further allowable for at least the same reasons as Claim 19. Claims 51 and 52 are

further allowable for at least the same reasons as discussed in connection with claims 46 and 47.

Claims 53-55 are further allowable for at least the same reasons as claim 3 and the independent

claims from which they depend (46, 47 and 51). Allowance of the newly added claims is

respectfully requested.

Request For Acknowledgment Of Provisional Application

This application claims the benefit of U.S. Provisional Application No. 60/110,125 filed

November 27, 1998. Acknowledgment thereof is respectfully requested.

Fees For Additional Claims

Please charge the fees associated with the submission of four (4) additional independent

claims ($336) and eight (8) additional total claims ($144), and any other fee due to deposit

account 09-0428.

Versions With Markings To Show Changes Made

In the Claims

18. (once amended) The method according to claim 1 and further comprising the steps of:

> storing at least one sequence comprising data representative of a plurality of presentations in a data store in operative connection with the first computer;[;]

> storing in the data store, data representative of presentations in the sequence that have been previously been made to the user;

> wherein in step (e) the computer is operative to select a presentation in the sequence not previously made to the user.

38. (once amended) The method according to claim 36 wherein the output data includes plurality of coupons, and wherein a coupon is [in] output in step (i).

46. (once amended) A method comprising the steps of:

> (a)   carrying out a financial transaction for a user through operation of an automated transaction machine by communicating at least one financial

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transaction message[s] between the transaction machine and a first

computer, <u>wherein the machine is operative to receive user identifying</u>

<u>data</u>; and

(b)   marketing at least one product to the user through operation of the

transaction machine by communicating <u>at least one</u> marketing message[s]

between the transaction machine and a second computer <u>responsive to the</u>

<u>user identifying data</u>.

47. (once amended) [The method according to claim 46 wherein step (b) is carried out] <u>A method</u>

<u>comprising</u>:

(a)   <u>carrying out a financial transaction for a user through operation of an</u>

<u>automated transaction machine by communicating at least one financial</u>

<u>transaction message between the transaction machine and a first computer;</u>

<u>and</u> concurrently [with step (a)] <u>during at least a portion of the financial</u>

<u>transaction</u>

(b)   <u>marketing at least one product to the user through operation of the</u>

<u>transaction machine by communicating at least one marketing message</u>

<u>between the transaction machine and a second computer</u>.

In the Abstract

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A marketing system includes a plurality of automated transaction machines (74, 76, 78, 80, 82, 84, 86). The automated transaction machines operate to carry out financial transactions with associated host computers (90, 94, 100, 104). Marketing presentations are stored on and output from the transaction machines responsive to messages exchanged with a market message server (110) which is connected to the automated transaction machines through a network (108). The connection to the automated transaction machines which provides delivery of the market presentation materials and which causes the output of presentations, is generally independent of the messages associated with authorizing financial transactions. Some described embodiments of the invention enable presenting marketing campaigns to users of the transaction machines. The marketing campaigns may include sequences of presentations that are output on a targeted basis to particular users. [Other marketing campaigns may be selectively distributed to groups of machines in the system and output without regard to the identity of the user of the machine. The system also enables analysis of marketing activity and communications with other systems for exporting and importing data and marketing presentations.]

Conclusion

Each of Applicants' pending claims specifically recite features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,

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